

### **REMARKS**

In the Office Action mailed on December 19, 2002, the Examiner stated that a restriction requirement was communicated by telephone on November 11, 2002. Mr. Donald Bobak made a provisional election of the claims of Group I, claims 1-15, with traverse. In the Office Action, the Examiner required affirmation of this provisional election. The Examiner objected to the drawings and to claim 7, and rejected claims 1-15 under 35 U.S.C. § 112, second paragraph. Claims 1-5, 7, 12, 14, and 15 were rejected under 35 U.S.C. § 102(b) and claims 8-10 and 13 were rejected under 35 U.S.C. § 103(a). By this amendment, claims 1-2, 4, 6-9, 11, and 14 have been amended. Claims 1-15 are under consideration.

The Applicant has considered the Action and the cited art and believes the present invention, as amended, is patentably distinct from the cited art, either individually or in combination with any other art.

The provisional election of the claims of group I, claims 1-15, with traverse, is hereby affirmed. Claims 16-25 have been withdrawn from consideration. The withdrawn claims have not yet been canceled because the Applicant maintains that the restriction requirement is improper.

The Examiner stated that the inventions of Groups I and II are distinct because the retroreflective article can be made by multiple processes. The Examiner cited deposition under vacuum, metal spluttering under vacuum, plasma deposition under vacuum, and thin metal film lamination under heat and pressure as examples of such processes. However, each of these examples falls within the limitations of claim 16, which simply recites (in pertinent part), "...applying a layer of reflective material to the substrate in such a way that said layer at least partially obscures a plurality of the pores of the substrate." Therefore, the Examiner has not shown that the inventions of Groups I and II are distinct. Reconsideration and withdrawal of the restriction requirement is respectfully requested.

The drawings were objected to because Figure 4 displays two reference numbers, 54 and 60, which appear to be pointing to the same structure. A proposed drawing correction in red ink, eliminating reference number 60, is enclosed herewith this Response. Upon the

Examiner's approval of this change to Figure 4, amended formal drawings will be presented. The specification has been amended with regard to the description of Figure 4, eliminating reference to number 60. It is not necessary to show a protective coating (60) in Fig. 4 to adequately describe the invention because the description of an optional coating would be clear to one of ordinary skill in the art without such a depiction in a drawing. Additionally, coating 60 is shown in figures 8 and 10 and is described in the specification in association with those figures. The Applicant respectfully requests withdrawal of the objection to the drawings.

Claim 7 was objected to as containing an informality. Claim 7 has been amended to recite "polyacetate" instead of "polyacetates." Withdrawal of this objection is respectfully requested.

The Examiner rejected claims 1-15 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. In response, claim 1 has been amended to provide proper antecedent basis for the limitation regarding the surface of the substrate. Claim 2 has been amended to recite "said layer of reflective material," as interpreted by the Examiner for purposes of examination rather than "said layer of metal." Claim 4 has been amended according to the Examiner's suggestion to read "less than 450 nm" instead of "less than the wavelength of visible light." Claim 6 has been amended to recite, "wherein said substrate is a fabric" instead of "wherein said substrate is in the form of a fabric." Claim 11 has been amended to delete the parenthetical phrase "about 0.025 to about 0.0025 mm" according to the Examiner's suggestion. Claim 14 has been amended to replace the recitations of "the side," found in lines 2 and 3, with "a surface" and "the surface" respectively, to provide proper antecedent basis for this limitation. The Applicant maintains that claims 1-15, as amended, are no longer indefinite under 35 U.S.C. § 112, second paragraph. Withdrawal of this rejection is respectfully requested.

The Examiner also rejected claims 1-5, 7, 12, 14, and 15 as anticipated by Lasch et al., U.S. Pat. No. 5,082,715. The Examiner alleges that Lasch discloses a conformable marking for road markings comprising a microporous thermoplastic sheet with a retroreflective material imbedded into the top layer adhered to the top surface of the base.

Claim 1 has been amended to include the recitation that the reflective material layer is selected from the group consisting of metal coatings and dielectric coatings, as originally presented in claim 8. As the Examiner stated with regard to claim 8 as filed, Lasch teaches the use of microspheres for retroreflectivity but does not teach the use of metal or dielectric coatings for this purpose. Therefore, Lasch does not teach or enable all of the elements of claim 1 as amended, or of claims 2-15, which depend from claim 1, as amended, either directly or indirectly. Withdrawal of this rejection is respectfully requested.

Claims 8-10 and 13 stand rejected as obvious over Lasch in view of Morris et al, U.S. Pat No. 5,673,148. To establish a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference or combine the references cited. This motivation may be in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner must also show that in modifying or combining references, there is a reasonable expectation of success, and that the references teach or suggest all of the claim limitations. (MPEP § 2143).

The Examiner alleges that Lasch teaches a microporous thermoplastic sheet with a retroreflective material imbedded into the top layer adhered to the top surface of the base, and that Morris teaches retroreflective elements comprised of transparent microspheres having a metal or dielectric coating on a hemispherical surface of the microsphere. However, claim 1, as amended, patentably distinguishes over Lasch and Morris. While Morris teaches the use of transparent microspheres having a metal coating, it does not teach a layer of metal or dielectric material located on the substrate, as claimed in the present invention. Morris clearly states, "When the optical body is a microsphere, the reflective member is a coating, typically substantially hemispherical, on the surface of each microsphere." (Column 4, lines 19-21.) Morris clearly indicates that the coating is not located on the substrate, as recited in claim 1, but rather is on an intervening structure, the microsphere. The restrictive language of claim 1, "consisting of metal coatings and dielectric coatings, located on the surface of the substrate" does not permit the introduction of an additional, intervening element, such as the microspheres of Morris. Thus, Lasch and Morris do not teach or suggest all of the claim

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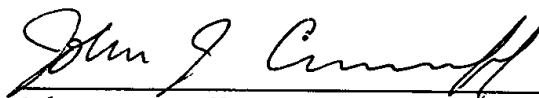
limitations of claim 1, either separately or together. Therefore, the Applicant maintains that the Examiner has not established a *prima facie* case of obviousness of the present invention as claimed. Likewise, the Applicant maintains that claims 2-15, which directly or indirectly depend from claim 1 and incorporate all of the limitations of claim 1, also patentably distinguish over the cited prior art. Withdrawal of this rejection is respectfully requested.

In light of the foregoing amendments and arguments presented herein, the Applicant respectfully requests reconsideration of the present application, withdrawal of the restriction requirement, and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph, 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a). A formal Notice of Allowance of claims 1-25 is earnestly solicited. Should the Examiner care to discuss any of the foregoing in greater detail, the undersigned attorney would welcome a telephone call.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

No fees are believed to be due at this time. Nonetheless, in the event that a fee required for the filing of this document is insufficient, the undersigned attorney hereby authorizes the Commissioner to charge payment of any fees associated with this communication, or to credit any overpayment to deposit account number 18-0987.

Respectfully submitted,



John J. Cunniff, Reg. No. 42,451  
Renner, Kenner, Greive, Bobak, Taylor & Weber  
First National Tower - Fourth Floor  
Akron, Ohio 44308-1456  
Telephone: (330) 376-1242  
Facsimile: (330) 376-9646  
E-mail: jjcunniff@rennerkenner.com

Attorney for Applicant

Dated: March 3, 2003  
Attachment - replacement drawing sheet